

REMARKS

Claim 24 has been canceled, and claim 26 (and the corresponding passage in the specification) has been amended to employ the more conventional term "tubule." Applicants respectfully note that "tablet" and "tablet" (or "tubule") are two separate elements of the claimed group, and that these elements are not the same. Claims 1 and 48 have been amended to clarify the invention and to better define the invention over the prior art. Claims 3-5, 22, 23, 25, 28, 29, 34, 55-57, 59, 63 and 67 have been amended to specify that the dielectric substrate is unitary. Claim 7 has been amended to change its dependency from claim 5 to claim 1. Claim 59 has been amended to clarify that the elements enumerated at the end of the claim are those that perform the "step of applying an alternating electric field." No new matter has been entered by these amendments.

With reference now to the 35 U.S.C. §112, first paragraph, rejection of claims 1 and 48, claim 1 has been amended to clarify that the phrase "zero velocity" refers to a "zero velocity in the direction of said dielectric substrate." In a similar vein, claim 48 has been amended to clarify that "the particles of said aerosol" are "essentially at respective fixed distances relative to the surface of said dielectric substrate." Support is found, e.g., in the specification at p. 4, lines 7-8 ("positioning them in a deposition zone proximate to the dielectric") as well as in FIGS. 5, 6, and 7, all of which show the trajectory of an exemplary particle as having essentially a zero velocity in the direction of the dielectric substrate, and having essentially a fixed distance with respect to the surface of the dielectric substrate – until the electric field is applied in the subsequent step, at which point the velocity of the particle in the direction of the dielectric substrate increases, and

HAYES SOLOWAY P.C.
130 W. CUSHING ST.
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567

its distance with respect to the surface of the dielectric substrate begins to decrease and is no longer fixed. Applicants further note that the current amendments to claims 1 and 48 also distinguish these claims over WO 98/42446, previously cited by the Examiner, which teaches moving charged particles toward the target substrate by the mechanical force of a spray nozzle, and thus cannot anticipate claims 1 and 48, which respectively require that, prior to the application of the electric field, the particles have “essentially a zero velocity in the direction of the dielectric substrate” and “essentially a fixed distance with respect to the surface of the dielectric substrate.” Thus, it is respectfully submitted that the §112 rejection as to claims 1 and 48 should be withdrawn.

Considering now the rejection of claims 1, 3-9, 14-23, 25-30, 32-37, 48, 49, 51-57, 59, 60, 62-67 and 69-71 as incomplete as omitting essential elements, under 35 U.S.C. §112, second paragraph, Applicants respectfully submit that this rejection should be withdrawn. The Examiner states that “the use of an air stream or nitrogen gas stream appears to be critical to the invention” and suggests that the Applicants’ failure to specify the method for moving the aerosol through the various regions in these claims renders them indefinite because of “an omission amounting to a gap between the elements.” This supposition is incorrect, and it appears that the Examiner is trying to force Applicants to narrow the scope of these claims in a manner not required by patent law. MPEP §2164.08(c), entitled “Critical Feature Not Claimed”, instructs that

an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure,

HAYES SOLOWAY P.C.
130 W. CUSHING ST.
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

—
175 CANAL STREET
MANCHESTER, NH 03101
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FAX. 603.668.8567

including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.

In fact, “[i]t remains axiomatic that claim language can be broader in scope than any limitations set forth in the specification.” *Maytag Corp. v. Whirlpool Corp.*, 95 F. Supp. 2d 888, 891 (N.D. Ill. 2000), *citing Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352 (Fed. Cir. 2000). The Court of Appeals for the Federal Circuit has held that “[a] claim need not claim every function of a working device.” *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d 1294, 1303 (Fed. Cir. 1999). In the case of Applicants’ invention, the specification at p. 7, line 6 mentions that “the aerosol gas may comprise air or any other suitable gas or gas mixture.” Moving the aerosol could be achieved in numerous ways, including mechanical means, e.g., a pump, a fan, a plunger, an agitator, a compressor, or other mechanical device. Applicants are not required to limit the claims by specifying a type of aerosol gas or a particular method of moving the aerosol, as such limitations are not critical to the invention being claimed. Indeed, the fact that Applicants’ disclosure contains broad language omitting this allegedly “critical” feature tends to rebut the Examiner’s argument of criticality, per MPEP §2164.08(c). Thus, Applicants respectfully submit that the rejection of claims 1, 3-9, 14-23, 25-30, 32-37, 48, 49, 51-57, 59, 60, 62-67 and 69-71 under 35 U.S.C. §112, second paragraph, is improper and should be withdrawn.

Regarding the rejection of claim 7 under 35 U.S.C. §112, second paragraph, the dependency of this claim has been changed from claim 5 to claim 1, and it is believed that this amendment renders the indefiniteness rejection moot.

Turning next to the art rejections, and considering the rejection of claims 3-5, 22, 23, 25, 28, 29, 32-35, 37, 49, 55-57, 59, 63 and 67 as either anticipated by or obvious over Snaddon et

HAYES SOLOWAY P.C.
130 W. CUSHING ST.
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

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175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567

al., U.S. Patent No. 4,533,368 ("Snaddon"), claims 3-5, 22, 23, 25, 28, 29, 34, 55-57, 59, 63 and 67 have been amended to specify that the dielectric substrate is unitary. To the contrary, Snaddon teaches that "[g]ranular dielectric material 6, such as polystyrene, preferably shaped as spheres or beads having a diameter of about 2-3 millimeters, is disposed within bed region 13 and retained therein by screen 8 having a mesh size sufficiently small to prevent material 6 from passing therethrough" (col. 3, lines 26-31).

Moreover, claims 3-5, 22, 23, 25, 28, 29, 34, 55-57, 59, 63 and 67 all require the step of "forming an aerosol of said particles in a first region." Snaddon's patent is entitled "APPARATUS FOR REMOVING RESPIRABLE AEROSOLS FROM AIR" and teaches a device for removing aerosols, not forming aerosols. Nowhere does Snaddon teach a step of forming an aerosol.

Since Snaddon neither teaches nor suggests a unitary dielectric substrate nor an aerosol forming step, Snaddon cannot anticipate or render obvious claims 3-5, 22, 23, 25, 28, 29, 34, 55-57, 59, 63 and 67, nor claims 32 and 33 depending from claim 34 or claims 35 and 37 depending from claim 22, which are patentable for the reasons given with respect to claims 22 and 34 as well as for their own additional limitations. Applicants therefore respectfully submit that the anticipation and obviousness rejections of claims 3-5, 22, 23, 25, 28, 29, 32-35, 37, 55-57, 59, 63 and 67 should be withdrawn.

Having dealt with the objections raised by the Examiner, the Application is believed to be in order for allowance. Early and favorable action are respectfully requested.

HAYES SOLOWAY P.C.
130 W. CUSHING ST.
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

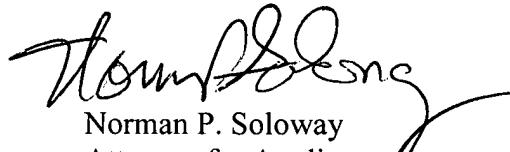
175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567



Serial No. 09/299,388
Docket: MICRODOSE 99.01 CON
Amendment H

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account No. 08-1391.

Respectfully submitted,


Norman P. Soloway
Attorney for Applicants
Reg. No. 24,315

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By Nicole M. Baldwin

NPS/KMD:nm

HAYES SOLOWAY P.C.
130 W. CUSHING ST.
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

—
175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567